

Application No. 10676,589
Amendment dated April 3, 2006
Reply to Office Action mailed December 1, 2005

REMARKS

The present Amendment is in response to the Examiner's Office Action mailed December 1, 2005. Claims 1-3, 6-9 and 12 are amended and new claims 13-20 are added. Claims 1-20 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

II. CLAIM REJECTIONS

A. Rejection Under 35 U.S.C. §102(c)

The Examiner rejects claims 1-3 under 35 U.S.C. § 102(c) as being anticipated by *Aihara* (United States Patent No. 6,491,447). Because the Examiner has not established that *Aihara* teaches or suggests each and every element of the rejected claims, Applicants respectfully traverse this rejection in view of the following remarks.

In order to anticipate a claim, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added); see MPEP 2131.

Aihara teaches an optical device module including a transparent structure 31 on which an optical fiber 15 and a light emitting device 37 are mounted. Col. 6, lines 14-17 (emphasis added); Figures 5A-5C. As clearly shown in Figure 5C of *Aihara*, the transparent structure 31 includes a V-shaped groove 52 upon which the optical fiber 115 rests. As shown in Figure 5A,

Application No. 10/676,589
Amendment dated April 3, 2006
Reply to Office Action mailed December 1, 2005

the light emitting device 37 transmits light that is reflected at a right angle from surface 34 and is received by fiber 15.

In direct contrast, independent claim 1 recites the element, "a holding sleeve configured to receive an optical fiber within the holding sleeve...when the optical fiber is inserted into said holding sleeve...." As described above, *Aihara* teaches that the fiber is mounted on the V-shaped groove 52. Since *Aihara* does not teach the coupling unit being claimed in this application, Applicants respectfully request that the rejection under 35 U.S.C. § 102(e) be withdrawn. Claims 2 and 3 depend from claim 1 and include every element of claim 1. Therefore, the Applicant requests that the rejections of claims 2 and 3 be withdrawn at least for the same reasons as claim 1.

B. Rejection Under 35 U.S.C. § 103

The Examiner rejects claim 4 under 35 U.S.C. § 103 as being unpatentable over *Aihara* in view of *Edwards* (U.S. Patent No. 6,793,406).

According to the applicable statute, a claimed invention is unpatentable for obviousness if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2005); *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966); MPEP 2142. Obviousness is a legal question based on underlying factual determinations including: (1) the scope and content of the prior art, including what that prior art teaches explicitly and inherently; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham*, 383 U.S. at 17-18; *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999). It is the initial burden of the PTO to demonstrate a *prima facie* case of obviousness, which requires the PTO to show that the relied upon references teach or suggest all of the limitations of the claims. MPEP 2142 (emphasis added).

According to MPEP section 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or

Application No. 10/676,589
Amendment dated April 3, 2006
Reply to Office Action mailed December 1, 2005

references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vacek*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added).

The Office Action relies on the application of *Aihara* to claim 1 to reject claim 4. As discussed above, Office Action has not established that *Aihara* teaches or suggests every element of claim 1. Therefore, the Applicant respectfully requests that the rejection of claim 4 be withdrawn at least for the same reasons set forth above with regard to claim 1.

Moreover, the Applicant notes that the Examiner appears to be relying on personal knowledge where the Examiner states on page 4 of the office action, "it is difficult to exactly match the refractive indexes due to a margin of error; a similar value of the two refractive index values would fall within the margin of error." In view of the foregoing, and pursuant to 37 C.F.R. 1.104(d)(2), Applicant hereby respectfully requests an Examiner affidavit that: (i) specifically identifies any and all references(s), other than those that have been specifically cited by the Examiner, upon which the obviousness rejection of claim 4 is based; and (ii) provides complete details concerning the reasoning and analysis of the Examiner concerning those references as those references are purported to apply to the rejection of claim 4. The Applicant makes an ongoing request for such Examiner affidavits where the Examiner relies on personal knowledge for rejection of the Applicant's claims.

The Examiner rejects claims 5 and 7-12 under 35 U.S.C. § 103 as being unpatentable over *Aihara*. The Office Action relies on the application of *Aihara* to claim 1 to reject claims 5 and 7-12. As discussed above, Office Action has not established that *Aihara* teaches or suggests every element of claim 1. Therefore, the Applicant respectfully requests that the rejection of claims 5 and 7-12 be withdrawn at least for the same reasons set forth above with regard to claim 1.

Further, the Examiner states, "it appears the invention would work equally as well with the inclined angle placed as suggested by the Applicant or placed as disclosed by *Aihara*." Again, it appears that the Examiner is relying on personal knowledge and the Applicant hereby requests an Examiner affidavit in support of all such assertions.

Application No. 10/676,589
Amendment dated April 3, 2006
Reply to Office Action mailed December 1, 2005

Regarding the rejection of claims 7-12, the Office Action fails to make a proper *prima facie* case of obviousness in as much as the rejection appears to rely on the Applicant's disclosure for motivation for the proposed combinations. The final step of the obviousness inquiry requires that concrete evidence of motivation for the missing elements be clearly set forth. "[The Patent Office] may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis." *In re Warner*, 154, USPQ 173, 178 (CCPA 1967). The PTO cannot simply make conclusions based on its own understanding or experience – or on its allegation of what would be basic knowledge or common sense. Rather, the PTO must point to some concrete evidence in the record in support of the findings. *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (emphasis added; footnote omitted). Thus, a *prima facie* case of obviousness has not been set forth along with concrete evidence of motivation in the prior art.

The Examiner rejects claim 6 under 35 U.S.C. § 103 as being unpatentable over *Aihara* in view of *Roberts* (German Patent No. 33 16 236). The Office Action relies on the application of *Aihara* to claim 1 to reject claim 6. As discussed above, Office Action has not established that *Aihara* teaches or suggests every element of claim 1. Therefore, the Applicant respectfully requests that the rejection of claim 6 be withdrawn at least for the same reasons set forth above with regard to claim 1.

The Applicant also notes that it appears that the Examiner has again failed to set forth the required motivation for the proposed combination. According to the Examiner on page 7, "[s]ince *Aihara* is silent on the process the coupling unit is made and *Roberts* discloses a similar module with the coupling unit injection molded, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have injection molded the coupling unit." However, Examiner doesn't advance any motive to make the allegedly obvious combination. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). In fact, it is error to reconstruct the Patentee's claimed invention from the prior art by using the patentee's claim as a "blueprint." When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the

Application No. 10/676,589
Amendment dated April 3, 2006
Reply to Office Action mailed December 1, 2005

combination other than the hindsight obtained from the invention itself. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985).

If the origin of teachings and motivation set forth for the proposed combinations exists in the references then the Applicants request that this origin be set forth by the Patent Office as suggested by MPEP 2144.08 III which states, "[w]here applicable, the finding should clearly articulate which portions of the reference support any rejection. Explicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. *Dillon*, 919 F.2d at 693, 16 USPQ2d at 1901; *In re Mills*, 916 F.2d 680, 683, 16 USPQ2d 1430, 1433 (Fed. Cir. 1990). Conclusory statements of similarity or motivation, without any articulated rationale or evidentiary support, do not constitute sufficient factual findings." (Emphasis added).

II. CLAIM REJECTIONS

New claims 13-20 have been added and are allowable at least for reasons similar to those set forth above regarding claims 1-12.


Application No. 10/676,589
Amendment dated April 3, 2006
Reply to Office Action mailed December 1, 2005

CONCLUSION

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 3 day of April, 2006.

Respectfully submitted,



DAVID A. JONES
Registration No. 50,004
Attorney for Applicant
Customer No. 022913
Telephone: (801) 533-9800

W:\16274\154n\ML0000002690V001.doc